

### REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 17-22 are pending, with Claims 17, 19, 21 and 22 amended by the present amendment.

In the Official Action, Claims 17 and 19 were rejected under 35 U.S.C. §112, second paragraph; Claims 17 and 19 were objected to; and Claims 17-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Agre (U.S. Patent 6,073,013) in view of Alperovich (PCT/US99/15132).

Claims 17, 19, 21 and 22 are amended to more clearly describe and distinctly claim Applicants' invention. Support for the present amendment is found in Applicants' originally filed specification.<sup>1</sup> No new matter is added.

Briefly recapitulating, Claim 17 is directed to a call originating method applied to a mobile communication terminal. The method includes receiving a table downloaded from a server storing a table containing an emergency telephone number for use in a user's motherland, a plurality of additional emergency telephone numbers for use in regions other than the user's motherland and which functionally correspond to the emergency telephone number for use in a user's motherland, and respective location information identifying the region where each of the plurality of additional emergency telephone numbers is in use. The method also includes storing the table in a first memory; specifying a terminal's present location coordinate; inputting said emergency telephone number for use in a user's motherland; and retrieving from the stored table one of said plurality of additional emergency telephone numbers whose corresponding location information designates a region including

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<sup>1</sup> Specification, Figure 4; page 23, line 9 to page 25, line 18.

the terminal's present location coordinate and whose functionality corresponds to the inputted emergency telephone number. The method includes *calling the retrieved telephone number*.

Agre describes a mobile telephone system employing a fleet of satellites and a set of gateway ground stations. The gateway system is configured to process telephone call connection requests from a mobile subscriber based upon the location of the subscriber unit. The system parses telephone numbers received from a subscriber unit based upon a parsing scheme of the locality in which the subscriber unit is located at the time the telephone call is placed. The system also identifies any emergency services number called (such as 911) and directs such calls to the nearest emergency services center to the current location of the subscriber unit.<sup>2</sup>

As to the emergency services, the ground station of Agre maintains a list of all or most emergency numbers in use anywhere in the world. The ground station compares a received telephone number to the list to identify whether the received number corresponds to one of the listed emergency services numbers. Thus, the user need not know the appropriate emergency services number in the country or locality in which he or she is currently located. Rather the user may simply use whatever emergency services code he or she is familiar with. Hence a user from the U.K. may dial 999 in the U.S. and be connected to the local 911 operator. If there is any ambiguity, perhaps because a telephone number used as an emergency services number in one country is used for another purpose in the locality where the user is located, in the system may further verify that the user wishes to be connected to an emergency services operator before completing the call. In this regard, the system may be configured to send an automatic voice mail to the subscribing unit requesting verification.<sup>3</sup>

In Agre, emergency calls are connected to the appropriate emergency services center nearest to the location of the subscriber unit. The ground station maintains a database

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<sup>2</sup> Agre, Abstract.

<sup>3</sup> Agre, column 12, lines 47-65.

identifying the locations of emergency services centers and compares the location of the subscriber unit with the database to identify the closest emergency services center. In this manner the user is not improperly connected with a distant emergency services center. By “appropriate” emergency services center, it is meant that the ground station determines whether the emergency telephone number specifies any particular emergency service and forwards the call to the closest such service.<sup>4</sup>

In particular, the ground station of Agre applies the location of the subscriber unit to table 522 to determine the appropriate parsing scheme. The parsing scheme is employed to determine whether the received telephone number is a local number, a long distance number or an international number. If the location is not within one of the countries listed, such as if the user is on a boat or aircraft, then the system may select the closest likely country or may merely require that the user enter a full international telephone number.<sup>5</sup>

However, as noted in the Official Action, Agre does not disclose or suggest downloading a table from a server to a mobile as recited in Applicants’ previous and current independent claims. Alperovich is cited for a teaching of downloading a table from a server to a mobile. Alperovich describes a method and apparatus for communicating information for use by subscriber in a mobile telephone communication system including mobile stations that are operable in a plurality of identifiable, distinct geographic areas. The method includes the steps of storing a database containing a plurality of information sets, each information set corresponding to one of the distinct geographic areas and containing information associated with a distinct geographic area that is of potential interest to a subscriber located in the geographic area. The method also includes determining a current distinct geographic area in which the mobile station is located, and transmitting the information set corresponding to the current distinct geographic area from the database to the mobile station. The mobile

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<sup>4</sup> Agre, column 12, line 65 through column 13, line 1.

<sup>5</sup> Agre, column 14, lines 11-20.

telephone communication system includes a memory device containing the database, and a transmitter operably associated with the memory device to transmit the information sets to a mobile station located in one of the plurality of distinct geographic areas.<sup>6</sup>

Furthermore, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the mobile of Agre with the table of Alperovich to arrive at Applicants' inventions recited in Applicants' independent claims. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that the rejection of Applicants' independent claims can be understood.<sup>7</sup>

Assuming *arguendo* that Alperovich can be properly combined with Agre to arrive at an embodiment where the table of Agre is downloaded from a server to a mobile, Applicants note that the table of Agre merely allows selection of a connection destination based on the telephone number corresponding to a call from a terminal. Indeed, the table shown in Figure 9 of Agre only stores connection destinations corresponding to respective telephone numbers. In other words, even if Agre and Alperovich are combined, a telephone number input to a terminal, e.g., 119, cannot be changed to another telephone number, e.g., 911. That is, both Agre and Alperovich fail to disclose or suggest changing an input number to a new number before dialing as recited in Applicants' original claims (i.e., calling a number retrieved from a database which is different than a number input for calling).

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

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<sup>6</sup> Alperovich, Abstract.

<sup>7</sup> MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both Agre and Alperovich fail to disclose all the features of Applicants' claimed invention.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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